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10/643,220	08/19/2003	Kiyotaka Ohara	116382	3455

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EXAMINER
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DEBROW, JAMES J

ART UNIT	PAPER NUMBER
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2176

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05/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/643,220

Applicant(s)

OHARA, KIYOTAKA

Examiner

James J. Debrow

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: RCE filed on 07 Feb 2007.
2. Claims 1-24 are pending in this case. Claims 1, 8, 15, 16, 17, 18, 19, 20, and 21 are independent claims.

### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07 Feb 2007 has been entered.

### ***Applicant's Response***

4. In Applicant's response dated 07 Feb 2007, Applicant added claim 23-24; argued against all objections and rejection previously set forth in previous Office Action.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US 6,362,894 B1; Filing Date Nov. 25, 1998) ('Shima-894') in view of Shima (US 6,867,874 B1; Filing Date Nov. 16, 1999) ('Shima-874').**

**With regards to independent claims 1, 8, 15-21, Shima-894 discloses a** printing system for printing over a network. The system consists of a file server, which is connected to the Internet via a router, and stores various information resources (*location data*) (column 5, lines 15-17; 103 in Fig 1). For example, a webpage can be stored on the server. Not only is the webpage stored on the server, it's URL (*location data*) is also stored on the server. Having the URL stored on the server, gives the system quick access to the specific webpage when trying to access it per user request; a network printer for printing out the obtained print data. As with the current invention, Shima-894 network printer contains a Receive Control Section (*location data request and receiving system*) for receiving *location data* that is downloaded from the server, a Memory (*data storage*) for storing data downloaded from the server, and a Printing Control Section (*printing device*) for printing the data downloaded from the server (column 5, lines 37-38; column 5, lines 62-64; column 5, lines 51-52; 11 in Fig 1; 13 in

Fig 1; 14 in Fig 1; 16 in Fig 1). From the webpage example, the webpage's URL (*location data*) is stored in a URL storage subsection (column 6, lines 43-44; 20 in Fig 1) of the storage section (*print data*) of the printer (19 in Fig 1). The printer requests (*locating data requesting system*) the server to transfer information according to the determined format, ie TXT, HTML, JPEG, etc. (*location data of the print data based on the data stored in said data storage*). After the server generates the location data of the print data (this would inherently happen after the server locates the requested webpage), it transfers (*data transmitting system*) the required information to the printer. Once the printer receives the information, it generates print image data and prints the document (column 6, lines 33-36). The printer is capable of accessing information resources without using the host computer (column 2, lines 41-44; column 7, lines 28-29; 2 in Fig 1);

Shima-894 does not disclose expressly *a computer accessible recording medium storing a program to be executed by a computer, to serve as a server/printer of a printing system that includes a server and a printer that can communicate with the server;*

*a list of location data;*

However, Shima-874 teaches *a computer accessible recording medium storing a program to be executed by a computer, to serve as a server/printer of a printing system that includes a server and a printer that can communicate with the server* (Shima-874

teaches the invention can be effected as a recording medium having such program for making the printer realized prescribed functions (column 2, lines 20-22). The printer is capable of directly obtaining a resource from the Web server on the network and printing such resources (column 3, lines 25-28)).

*a list of location data* (Shima-874 teaches when provided a URL (*list of location data*), the printer sends a connection request to the Web server in accordance with such URL and receives a connection completion from the Web server. As with the current invention, the printer sends a transfer request of a resource and its structure data to the Web server (*transmit a request for list of location data*) (column 3, lines 8-49). A transfer request is only made for printable data. Data unprintable with a printer is not transmitted from the server (column 7, lines 60-63)).

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Shima-894 with Shima-874 for the benefit of shorten the time from obtaining the resources until printing the resources (column 7, lines 63-64).

**With regards to dependent claims 2 and 9,** Shima-894 doesn't explicitly disclose a mechanism for updating the resources (*location data*) stored in location data storage, however it would be inherent to anyone of ordinary skill in the art that there would be such a mechanism in place, as the data in most databases is not constant.

There is always at least one mechanism for adding and deleting information within the database. Shima-894 does not disclose expressly *a list of location data*;

However, Shima-874 teaches *a list of location data* (Shima-874 teaches when provided a URL (*list of location data*), the printer sends a connection request to the Web server in accordance with such URL and receives a connection completion from the Web server. As with the current invention, the printer sends a transfer request of a resource and its structure data to the Web server (*transmit a request for list of location data*) (column 3, lines 8-49). A transfer request is only made for printable data. Data unprintable with a printer is not transmitted from the server (column 7, lines 60-63)).

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Shima-894 with Shima-874 for the benefit of shorten the time from obtaining the resources until printing the resources (column 7, lines 63-64).

**With regards to dependent claims 3 and 10**, Shima-894 discloses a URL storage subsection within the network printer for storing a URL specified by the host computer (column 6, lines 10-11; 20 in Fig1). Based on the established meaning of an URL, the scope of this subsection is identical to the scope of the current invention *designating system to designate one of a plurality of locations, which are indicated by the location data, corresponding to the print data to be printed.*

**With regards to dependent claims 4 and 11,** Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data. Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894 doesn't explicitly state that both printable and unprintable data are stored on the server, and that the location data generating system generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 also discloses a URL storage subsection within the network printer for storing a URL specified by the host computer (column 6, lines 10-11; 20 in Fig1). Based on the established meaning of a URL, the scope of this subsection is identical to the scope of the current invention *designating system to designate one of a plurality of locations, which are indicated by the location data, corresponding to the print data to be printed.*

**With regards to dependent claims 5 and 12,** Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data. Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894 doesn't explicitly state that both printable and unprintable data are stored on the server, and that the location data generating system



generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 also discloses a URL storage subsection within the network printer for storing a URL specified by the host computer (column 6, lines 10-11; 20 in Fig1). Based on the obvious meaning of an URL, the scope of this subsection is identical to the scope of the current invention *designating system to designate one of a plurality of locations, which are indicated by the location data, corresponding to the print data to be printed.*

Even though it is inherent that the designating system would have means for extracting location data of the print data from location data received, Shima-894 does not disclose expressly that the *designating system includes an extracting system that extracts the list of location data of the print data from the location data received by the location data receiving system.*

However, Shima-874 discloses the printer analyzes the text of the resources received from the server, *extracts the URL (list of location data) of the structural data and sends a transfer request of the structural data in accordance with the URL* (column 3, lines 8-49). Shima-874 discloses the data distinguishing unit stores information in correspondence with each data format regardless whether or not it is printable data) (column 7, lines 8-10).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a mechanism for extracting the URL from the location data, providing the benefit of determining the location of the print data.

**With regards to dependent claims 6 and 13**, as with the current invention, Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data. Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894 doesn't explicitly state that both printable and unprintable data are stored on the server, and that the location data generating system generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 does not disclose expressly that *said transmitting system selectively transmits only the location data of the print data*. However he does disclose that in one embodiment of his invention, only preset information of specified information resources is received and printed (column 7, lines 34-35). Using the broadest interpretation of this statement, the examiner presume that if one were to preset specific information about the resources that were to be received, then only those selective resources would be transmitted based on the preset information. Therefore, the examiner concludes that

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this preset information could include *only transmitting the location data of the print data*, as oppose to transmitting both print data and unprintable data.

Therefore it would have been obvious to combine Shima-874 with Shima-894 for the benefit of being able to selectively determine the specific type of data that the server is to transmit.

**With regards to dependent claims 7 and 14**, as with the current invention, Shima-894 discloses a process to determine whether the data received by the printer is printable or unprintable data. Shima-894 uses a format management table to determine whether the format of specific data is receivable (print data) or un-receivable (*unprintable data*) (column 6, lines 11-18; Fig 2). Even though Shima-894 doesn't explicitly state that both printable and unprintable data are stored on the server, and that the location data generating system generates a location for both, and transmits them, this is nevertheless implied, because in order for the printer to distinguish printable data from unprintable data, the server must be capable of transmitting both printable data and unprintable data to the printer.

Shima-894 does not disclose expressly that *said transmitting system includes an extracting system that extracts the location data of the print data from the location data stored in said location data storage, said transmitting system transmitting the location data extracted by said extracting system.*

However, Shima-874 discloses that the web server transmits resources requested by the printer based on the printer's request message in accordance with an

URL (column 4, lines 34-39). Therefore, the examiner concludes that if the printer has a mechanism for extracting the URL (*list of location data*) from the resources transmitted by the server, and a mechanism for including an URL (*list of location data*) in it's request for resources to the server, then inherently the transmitting system on the server would have a mechanism for *extracting* the URL (*list of location data*) of the print data in storage, so it can be included in the response message to the printer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a mechanism for *extracting* the URL (*list of location data*) of the print data in the data storage in order to include it in the resource information that is transmitted to the printer in response to the printer's request of the specified resources.

**With regards to dependent claim 22**, Shima-894 does not disclose expressly *the printing system according to claim 1, wherein the list of location data comprises a list indicating storage of a plurality of pieces of print data.*

However, Shima-874 teaches *the list of location data comprises a list indicating storage of a plurality of pieces of print data* (Shima-874 teaches when provided a URL (*list of location data*), the printer sends a connection request to the Web server in accordance with such URL and receives a connection completion from the Web server. As with the current invention, the printer sends a transfer request of a resource and it's structure data to the Web server (*transmit a request for list of location data*) (column 3, lines 8-49). A transfer request is only made for printable data. Data unprintable with a printer is not transmitted from the server (column 7, lines 60-63)).

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Shima-894 with Shima-874 for the benefit of shorten the time from obtaining the resources until printing the resources (column 7, lines 63-64).

**With regards to dependent claim 23**, Shima-894 discloses *the printing system according to claim 1, wherein the list of location data is document data different from the print data* (col. 6, lines 25-54; Shima-894 disclose the network printer accesses the specified URL (*location data*) and request the transfer of an HTML source code in which is used to generate print image data (*print data*) and prints. Shima-894 further discloses the URL is stored in the URL storage section subsection in the storage section and a Web page specified in the URL is accessed. Thus Shima-894 discloses location data and print data is different.).

**With regards to dependent claim 24**, Shima-894 does not disclose expressly *the printing system according to claim 1, wherein the location data requesting system transmits the request for the list of location data to the server when the printer receives an instruction to display the list of file names of the print data by a user operation.*

However, Shima-874 teaches *the location data requesting system transmits the request for the list of location data to the server when the printer receives an instruction to display the list of file names of the print data by a user operation* (Shima-874 teaches when provided a URL (*list of location data*), the printer sends a connection request to

the Web server in accordance with such URL and receives a connection completion from the Web server. As with the current invention, the printer sends a transfer request of a resource and its structure data to the Web server (*transmit a request for list of location data*) (column 3, lines 8-49). A transfer request is only made for printable data. Data unprintable with a printer is not transmitted from the server (column 7, lines 60-63)).

Therefore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Shima-894 with Shima-874 for the benefit of shorten the time from obtaining the resources until printing the resources (column 7, lines 63-64).

**Note**

7. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

***Response to Arguments***

8. Applicant's arguments filed 07 Feb 2007 have been fully considered but they are not persuasive.
9. Applicant argues *Shima '874 fails to provide any disclosure with regard to using the printer to request a list of URLs from the server.*

The Examiner disagrees.

Shima '874' teaches *using the printer to request a list of URLs from the server* (col. 3, lines 11-45; Shima '874' teaches the printer makes a transfer request of a resource text to the Web server. The resource text contains a list of registered URLs. Shima '874' further teaches the URL designator may be structured such that the desired URL can be input upon selecting one from a previously registered URL list. Thus Shima '874' teaches using the printer to request a list of URLs from the server.).

Therefore at the time of the invention it would have been obvious to a person of ordinary skill in the art to combine Shima '894' with Shima '874' provide a mechanism for extracting the URL from the location data, providing the benefit of determining the location of the print data.

***Note***

10. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the reference should not be considered to

be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art.

See, MPEP 2123.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James J. Debrow whose telephone number is 571-272-5768. The examiner can normally be reached on 8:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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